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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/451,160	11/30/1999	STEVEN R. BOAL	80.142-002	8692

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EXAMINER

CHAMPAGNE, DONALD

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 08/27/2002

18

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/451,160

Applicant(s)

BOAL, STEVEN R.

Examiner

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 and 21-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 21-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 November 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 14.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to After Final Amendment

1. Amendment B submitted on 18 July 2002 (Paper No. 15), in response to the indication of allowable subject matter in the Final Rejection (Paper No. 13, filed 26 April 2002), has been entered. However, review of the proposed allowance identified new prior art. A non-final rejection follows.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
3. Claims 24 and 25 are rejected under 35 U.S.C. 103(a) as obvious over Mankoff in view of Sutherland and Schreiber et al.
4. Mankoff teaches (independent claim 24) providing a coupon to a consumer who clicks on a website ad (col. 5 lines 3-6 and col. 1 line 28), which reads on: associating a URL including a promotional code with a coupon (because "promotional code" is disclosed only to be an appendage to the URL, and that reads on the normal filename appendage of a URL); displaying the coupon to the user; and invoking the URL with a browser to thereby enable the user to redeem the coupon.
5. The references do not teach clicking on the displayed coupon (claim 25), but, for the sake of reinforcement, it would have been obvious to require clicking on the coupon when it is displayed.
6. Claims 1-6, 9-18, 22 and 23 are rejected under 35 U.S.C. 103(a) as obvious in view of the references given above, and further in view of Emaginet.
7. The references given above do not teach (claim 1) collecting information from a client system without obtaining information sufficient to specifically identify the user. Emaginet teaches collecting information from a client system, which reads on "a device of a client

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system", without obtaining information sufficient to specifically identify the user, which reads on "device information". Because it would protect user identity, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Emaginet to those of the references given above.

8. None of the references teach associating a device ID with the device information at the main server system. However, under the principles of inherency (MPEP § 21112.02), since the reference invention necessarily performs the method claimed, the method claimed is considered to be anticipated by the reference invention. As evidence tending to show inherency, it is noted that Emaginet does teach sending "offers" directly to the user's desktop, which reads on device, which would necessarily require identification (ID) of the device. Since targeting requires sending offers consistent with the device information, the device information is necessarily associated with the device ID.
9. Emaginet also teaches selecting coupons according to the device information, and also therefore according to the device ID because the latter is associated with the former; and transmitting the selected coupons from the main server system to the client system.
10. Emaginet teaches claims 3 and 21, inherently, as noted in para. 7 above.
11. Emaginet teaches: (claim 4) printing a coupon at the client system.
12. Emaginet teaches claims 5 and 6 inherently. Since (claim 5) the selecting is done according to the device ID, the request must include the device ID. The device ID must be automatically included (claim 6) because there is no other way for the ID to be provided. (The user does not know the ID.)
13. Emaginet teaches (claims 14 and 15) transmitting advertising data, because a coupon reads on advertising data.
14. The references do not teach (claims 2 and 20) that the demographic characteristics include the user's postal zip code or state of residence. Because many products can best be targeted by geographic region (e.g., regional foods or resort services), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to include postal zip code or state of residence in the collected demographic characteristics.
15. Emaginet does teach (claims 9 and 10) a GUI. The references do not teach displaying a flashing icon when a new coupon is available. Because they are both a convenience and a

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reward for users, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to display a flashing icon when a new coupon is available.

16. The references do not teach (claims 11-13, 22 and 23) encrypting or double encrypting the coupons. Because coupons are valuable and encryption discourages theft, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to encrypt or double encrypting the coupons, the double encryption used for the more valuable coupons.
17. Emaginet does not teach (claims 16-18) storing and encrypting a user detected events history file. Because purchase (detected) events are useful in targeted marketing and because encryption would help protect the user's privacy, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to store and encrypt a user detected events history file.
18. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as obvious over the references given above and further in view of Phaal. The references given above do not teach automatic request transmission at predetermined intervals. Phaal teaches automatic request transmission at predetermined intervals (col. 3 lines 47-55 and col. 12 lines 42-45). Because Phaal teaches that the invention is a low cost mechanism to significantly enhance service (col. 2 lines 44-45), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teaching of Phaal to those of the references given above.

Conclusion

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L. Champagne whose telephone number is 703-308-3331. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications may be sent directly to the examiner at 703-746-5536.
20. The examiner's supervisor, Eric Stamber, can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular official communications and 703-872-9327 for After Final official communications. Any inquiry of a general nature or relating to the status of this application

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or proceeding should be directed to the receptionist whose telephone number is 703-306-5771.

21. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.



Donald L. Champagne
Examiner
Art Unit 3622

10 August 2002